

REQUEST FOR RECONSIDERATION OF FINAL REJECTION

Applicant requests that this Final Rejection be withdrawn pursuant to MPEP sections 706.07(c), 706.07(d), and 706.07(e).

REQUEST FOR PERSONAL INTERVIEW

MPEP section 714.12 states that “The prosecution of an application before the examiner should ordinarily be concluded with the final action. **However, one personal interview by applicant may be entertained after such final action if circumstances warrant**”. Applicant would like to request a personal interview with the examiner in his case, within the time from mailing of this response to the Final Rejection and the transmission of the Advisory Action. Applicant realizes that an Applicant has no right to an interview after Final Rejection and that such interviews are always at the discretion of the examiner. Because of the allowable subject matter, and the present amendment to the claims, Applicant earnestly believes that an interview will lead to the allowance of claims, thus, Applicant respectfully requests such action on this case.

REQUEST THAT AMENDMENT BE ENTERED

The claims presently on file in the above-identified application, as amended herein, are now believed to be written in full, clear, concise, and exact terms as to be enabling to one skilled in the art, and therefore the allowance of these claims is earnestly requested. In amending these claims, no new matter has been added. Applicant hereby respectfully requests, pursuant to 37 CFR 1.116 and MPEP section 714.12, that this amendment be entered. This amendment places the application either in condition for allowance or in better form for appeal, and therefore it may be entered by the examiner.

REMARKS/ARGUMENTS

A. In the Claims

1. Claims 1-6 and 8-20 are pending in this application. Claims 1, 2, 6, 8, 10, 16, and 20 have been amended to correct language, syntax, avoid the citation of the prior art, and/or point out the specific novel and non-obvious features of Applicant's invention with greater clarity. Claim 6, 12, 17 and 19 have been cancelled. No new claims have been added. No new matter has been added.

B. *Regarding the Claim Rejections under 35 U.S.C. 103*

2. Applicant acknowledges the quotation of the appropriate paragraph of 35 U.S.C. 103 that forms the basis for the rejections under this section made in the office action.

3. Claims 1-6 and 8-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto (JP 59022583). Applicant respectfully disagrees with this obviousness rejection in light of the arguments presented below.

(A) 35 USC 103(a) states in part that "if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious...[emphasis added]" The examiner has relied upon one reference, the Miyamoto Japanese patent in this case to argue that the instant invention "as a whole" would have been obvious. This is simply not the case. Claim 1 of the instant application goes way beyond the Miyamoto reference such that the subject matter sought to be patented here differs completely in nature than that protected, taught and disclosed in the Miyamoto reference.

In determining whether subject matter would have been non-obvious under 103(a), we follow the guidance of the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 13-14 (1966), and determine (1) the "*scope and content* of the prior art," then (2) ascertain the "differences between the prior art and the claims at issue," to (3) resolve the "level of ordinary skill in the pertinent art." To reject claims in an application under section 103, an examiner must

show an un rebutted *prima facie* case of obviousness. A closer look at the Graham factors here show that the examiner has not arrived at an un rebuttable *prima facie* case of obviousness for the present invention.

(1) The scope and content of the prior art here involves one Japanese patent issued to Yasuo Miyamoto in 1985. The title is: METHOD FOR PRESERVING FRESHNESS OF VEGETABLE AND FRUIT. We only have the abstract translated, and so we must only turn to that which we can infer from that abstract. This is very limited. The abstract reads: PURPOSE: To activate and revive a vegetable or fruit about to wilt without losing the freshness on appearance and composition, e.g. vitamin, for a long period, by bringing the vegetable or fruit into contact with an aqueous solution containing a specific mineral.

CONSTITUTION: [description of preparation of the dipping solution] A vegetable or fruit is then dipped in the resultant solution for several seconds (sic) ~ 30 min with in 24hr or sprayed therewith using a spray, etc.

Regarding the scope and content of the prior art, this is all we have. Applicant attempted to obtain a translation of the entire patent, from Japanese to English, for the purpose of further analysis. The translation could not be made, as the copy Applicant received from the examiner was not legible when enlarged. The tiny katakana and kanji characters could not be read by our Japanese translator. When enlarged by photocopier machine, the characters ran together and again, could not be deciphered. Therefore, this is all we have to go on. This is the sum total of the scope and content of the prior art relied upon in the final rejection and this response.

Miyamoto teaches an Oak tree ash based solution for dipping or spraying on fruit or vegetables for the sole purpose of “to activate or revive a vegetable or fruit.” The Miyamoto solution is not meant to be consumed, rather it is intended to be washed away from the dipped or sprayed fruit or vegetable before that food is consumed. This is nothing but common sense. The examiner jumps to the conclusion, erroneously, that because the previously treated fruit and/or vegetable is consumable, so should the mineral dipping solution or spray. No one would eat such dipped or sprayed food, it would alter the taste and spoil the enjoyment of eating.

(2) Ascertaining the differences between the prior art and the claims at issue is relatively

straightforward. Miyamoto is directed at producing a mineral dip or spray for treating fruit or vegetables that are about to wilt. Keeping in mind most inventions come from a combination of old elements and each element may be found in the prior art, mere identification in the prior art of each element is insufficient to defeat the patentability of *the combined subject matter as a whole*. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998). In the instant case, the examiner has not shown that each element is present in the prior art, nor has she shown that Miyamoto is even analogous art. Miyamoto treats edible plants about to wilt (fruits and vegetables), while Applicant's invention is directed at ways for humans and animals to consume mineral rich compositions for enhancing nutrition and treating ailments, such as osteoporosis. The "analogous art test" has long been a part of the primary Graham analysis. The analogous art test requires that the examiner show that a reference is either in the field of Applicant's endeavor or is reasonably pertinent to the problem the inventor was concerned, in order to rely on that reference as a basis for rejection. A reading of the examples (paragraphs [0032] to [0045]) articulated in the specification clearly establish that Applicant was concerned with discovering a method in which a mineral rich composition can be varyingly prepared specifically for consumption by people and animals, and specifically to deliver varying amounts of differing mineral content. The invention discloses this method, and the solution to the problem of making ash mineral edible is evident.

The instant invention is novel and non-obvious in at least two ways: (1) in the method for preparing the mineral composition having a varied mineral content depending upon the initial plant material used and its analyzed mineral content, and (2) in the method which is used to make the mineral composition actually palatable and ultimately consumable by humans and animals. Miyamoto makes neither of these features of the present invention obvious. Miyamoto does not teach or remotely suggest either feature. In fact, if Miyamoto had patented in the US, it would not be in the same US class/subclass as the present invention (Miyamoto is 426/321 whereas the present application has been initially assigned 426/72). The two inventions are worlds apart.

On page 2 of the final rejection the examiner states "Miyamoto discloses that fruits and vegetables can be dipped into the mineral composition, which means that the mineral mixture is suitable for human consumption." Rejections based on obviousness grounds cannot be sustained

by mere conclusory statements such as this. Instead, there must be some articulated reasoning with some rational underlining to support the legal conclusion of obviousness. In re Leonard R. Kahn, No. 04-1616 (Fed. Cir. 2006) decided on March 22, 2006, and citing In re Lee, 277 F.3d 1338 (Fed. Cir. 2002) and In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998).

The mineral residue created by Miyamoto for dipping and spraying would have to be washed off the vegetable or fruit before consumption. This action would leave little or no mineral content left on the food subsequently eaten. Therefore, the consumer does not get any dose of minerals by eating the food that has been activated or revived by the method and composition of Miyamoto. The examiner's contention that "the mineral mixture is suitable for human consumption" because "Miyamoto discloses that the fruits or vegetables can be dipped into the mineral composition" is not logical, is not supported, speculation and an improper conclusion. Miyamoto meant the ash dip to be used for activating and reviving foodstuffs, and not to be subsequently consumed, but rather washed off prior to consumption.

The examiner's theory that Miyamoto somehow "discloses a process for making a nutritional composition" is not at all supported by the reference abstract that the examiner solely relies on. Nothing Miyamoto discloses or teaches even remotely suggests that the mineral dip/spray solution be consumed along with the activated or revived fruit or vegetable. Certainly, no one would infer from a reading of the Miyamoto abstract, that the invention was meant to provide consumable minerals for people. That is clearly not its intent or purpose.

(3) The level of ordinary skill in the present art cannot be resolved by a reading of the prior art here, because the reference is not analogous art. Miyamoto is focusing on produce, and keeping it from losing its freshness, Applicant is a PhD biochemist, research physician, and an expert in formulating nutritional supplements. If we are to assume that the level of ordinary skill in the art is a PhD research physician, there is no motivation for this individual to look to Miyamoto or any other related art for answers on formulating new mineral compositions for human and animal consumption. Medicine and nutrition biochemistry is the real pertinent art. The examiner has not shown the motivation for selecting the reference and combining it with skill in the medical/nutritional arts to render the claimed invention obvious. This entails

consideration of both (1) and (2) above in analyzing the Graham factors. When an examiner does not explain motivation, or the suggestion or teaching that would have led the skilled artisan at the time of invention to *the claimed combination as a whole*, improper hindsight was used to conclude that the invention was obvious. In re Leonard R. Kahn, No. 04-1616 (Fed. Cir. 2006) decided on March 22, 2006.

If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of the reference in an obviousness rejection. This is because an inventor may well have been motivated to consider the reference when making his invention. If the reference is directed to a different purpose, the inventor would have less motivation or occasion to consider it. *Id.* Kahn, citing In re Clay, 966 F.2d 656, 659-60 (Fed. Cir. 1992).

It is not at all obvious from the disclosure and teachings of Miyamoto to generate a mineral composition for consumption by humans and animals. Miyamoto's invention is a fruit or vegetable dip or spray and the ash minerals therein were in no way intended for consumption. The fruit or vegetable so treated is consumed, yes, but only after they have been washed and the dipping solution completely washed away. There simply could not be any other logical way. Imagine the taste of such a solution coated onto a fruit or vegetable. This would render the food unpalatable and very likely horrible in taste, or even inedible prior to a thorough washing.

Everyone has been told from a very young age by their mothers and fathers to wash every piece of fruit or vegetable before eating it or preparing it for eating. All people and many animals are very sensitive to the taste of food, and most would not even think of eating ash of any kind, no matter how it is prepared, processed or flavored. The present invention, unlike Miyamoto, changes that in a novel, non-obvious and profound way, by making a mineral composition made from plant ash actually palatable, easily consumable, and in the case of effervescence, even fun to consume. None of this is even remotely suggested by Miyamoto.

CASE LAW CITED BY EXAMINER IS NOT APPLICABLE HERE

Examiner's reliance on *In re Levin* to reject claims in the instant application is misplaced.

In re Levin does not stand for the proposition that all recipes and methods of preparing food are

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strictly unpatentable. That is not the case. There are thousands of recipe patents, and even more patents covering the preparation of food. If the recipe or method for preparing food is useful, novel and non-obvious, it can be protected by patent, just like all other inventions “under the sun.” For example, US Pat. No. 7,008,655 B1, issued on March 7, 2006 in US Cl. 426/94 covers the process for making a baked cup shaped food product, which is nothing more than a recipe for preparing a novel foodstuff.

The present invention does not define a recipe or a formula for cooking food. Far from it. The instant mineral composition is derived from burning plant material down to pure ash. In many cases the plant material is otherwise inedible itself, such as eucalyptus leaves, etc. Burning plant material is not cooking food. The examiner cannot name one foodstuff that is completely oxidized to ash before consumption. Cooking food and burning plant material is mutually exclusive and there are no recipes or methods for preparing food that includes the step of completely burning any one of the ingredients, as is required in the instant invention. Therefore, In re Levin cannot be considered on point in the fact situation of the instant case.

Moreover, there is something patentable in the present application. The examiner reinforces and supports this by making claims 19 and 20 allowable subject matter if rewritten. Applicant has shown a co-action or cooperative relationship between the selected ingredients which produces a new, unexpected and useful function. That is, that many different mineral compositions can be made with varying mineral content, for different applications, and that this mineral composition can be made, in a novel and non-obvious way to be readily consumable by people and animals. In contrast, Miyamoto says nothing about the ash being consumable or actually consuming the ash with the revived fruit.

CLAIMS REJECTIONS

Claims 1-6 and 8-20 are pending in this application. Claims 1, 2, 8, 10, 16, and 20 have been amended to avoid the citation of the prior art, and/or point out the specific novel and non-obvious features of Applicant's invention with greater clarity. Claim 6, 12, 17, 18 and 19 have been cancelled. No new claims have been added. No new matter has been added.

Claim 1-6 and 8-18 have been rejected under 103(a) as being unpatentable over
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Miyamoto.

1. Claim 1 has been amended to further clarify and point out the nature of Applicant's invention, as disclosed in the specification, with respect to the steps of isolating the reacted form of the plant ash and processing the isolated reacted form of the plant ash **to a solid**, for the purpose of making a consumable nutritional mineral supplement composition. Based upon the foregoing arguments and remarks, Applicant believes that claim 1, and all of its dependent claims are not obvious in light of Miyamoto and are now in condition for allowance.

2. Claim 2 has been amended, and depends on claim 1. Claim 2 is now in condition for allowance.

3. Claims 3-5 are as originally filed, and depend on claim 1. Claims 3-5 are now in condition for allowance.

4. Claim 6 has been cancelled.

5. Claim 7 was previously cancelled.

6. Claim 8 has been amended, and depends on claim 1. Claim 8 is now in condition for allowance.

7. Claim 9 is as originally filed, and depends on amended claim 8. Claim 9 is now in condition for allowance.

8. Claim 10 is amended, and depends on claim 8. Claim 10 is now in condition for allowance.

9. Claim 11 is as originally filed, and depends on claim 8. Claim 11 is now in condition for allowance.

10. Claim 12 has been cancelled.

11. Claims 13-15 are as originally filed. Claims 13-15 are now in condition for allowance.

12. Claim 16 is amended to include the allowable limitations of claims 17 and 19, and

claim 16 depends on claim 1. Claim 16 is now in condition for allowance.

13. Claim 17-19 have been cancelled.

14. Claim 20 has been amended and depends on amended claim 16. Claim 20 is now in condition for allowance.

CONCLUSION

All of the objections and rejections raised by the Examiner have been addressed by Applicant. Attorney for Applicant has carefully reviewed the cited reference, namely the Miyamoto patent, and believes that the new claims presently on file in the subject application are patentably distinguishable with respect to the prior art. In view of the amendments to the claims and the remarks submitted herein, Applicant submits that all of the new claims of record are in condition for allowance and respectfully requests that a Notice of Allowance be issued in this case in due course.

If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this application to allowance, the Examiner is invited to contact the undersigned, attorney of record in this case, Richard D. Clarke, Esq., at one of the listed below numbers or at his below listed e-mail address.

Dated: April 3, 2006 Respectfully submitted,

LAW OFFICE OF RICHARD D. CLARKE

By Richard D. Clarke

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